

REMARKS

The Office Action dated October 10, 2006 has been received and carefully noted. The above amendments to claims 1, 9-11, 14, 20, 22-23, and 27, add new claim 34, and the following remarks, are submitted as a full and complete response thereto. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-34 are pending and under consideration.

REJECTION UNDER 35 U.S.C. § 112:

In the Office Action, at page 2, claims 11-19 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

In response, the claims have been amended to improve clarity and antecedent support.

Accordingly, it is respectfully requested that the § 112, second paragraph rejections to the claims be withdrawn.

REJECTION UNDER 35 U.S.C. § 103:

In the Office Action, at page 2, claims 1, 2, 4-6, 9-12, 14, 15, 21, and 23 were rejected under 35 U.S.C. § 103 as being unpatentable over U. S. Patent No. 6,741,678 to Cannell et al. ("Cannell") in view of U.S. Patent No. 5,657,372 to Ahlberg et al. ("Ahlberg"). The Office Action took the position that Cannell and Ahlberg describe all

the recitations of independent claims 1, 11, 14, and 23 and related dependent claims.

Applicants respectfully traverse this rejection.

Independent claim 1, upon which claims 2-10 are dependent, recites a method, including detecting a call establishment request, in response to said detecting, alerting a called terminal, in response to said alerting, setting up a two-way connection between a calling terminal and the called terminal, determining that a two-way voice call between the calling terminal and the called terminal is not allowed, receiving silent messages via the called terminal and/or the calling terminal, and conveying information based on said silent messages to the calling terminal and/or the called terminal, respectively.

Independent claim 11, upon which claims 12-13 are dependent, recites an apparatus, including a detecting unit configured to detect a call establishment request, an alerting unit configured to alert a called terminal in response to said call establishment request, and a setting up unit configured to set-up, in response to said alerting, a two-way connection between a calling terminal and the called terminal. The apparatus also includes a determining unit configured to determine that a two-way voice call between the calling terminal and the called terminal is not allowed, a receiving unit configured to receive silent messages via the called terminal, and a conveying unit configured to convey information based on said silent messages to the calling terminal.

Independent claim 14, upon which claims 15-19 are dependent, recites an apparatus being configured to detect a call establishment request, in response to said

detection, set up a two-way connection between a calling terminal and a called terminal, determine that a two-way voice call between the calling terminal and the called terminal is not allowed, receive silent messages via the called terminal, and convey information based on said silent messages to the calling terminal.

Independent claim 20, upon which claims 21-22 are dependent, recites a user interface in a called terminal and/or a calling terminal, wherein the user interface is configured to select a desired call mode, in response to said selection, setting up a two-way connection between the calling terminal and the called terminal, and if a two-way voice call between the called terminal and the calling terminal is not allowed, receive silent messages from the calling terminal and/or the called terminal.

Independent claim 23, upon which claims 24-33 are dependent, recites a communication system configured to detect a voice call establishment request from a calling terminal to a called terminal, in response to said detecting, alert the called terminal, in response to said alert, set up a two-way connection between the calling terminal and the called terminal, determine that a two-way voice call between the calling terminal and the called terminal is not allowed, and receive silent messages via said called terminal and/or calling terminal and convey information based on said silent messages to the calling terminal and/or the called terminal, respectively.

Independent claim 34 recites a apparatus, including means for detecting a call establishment request, means for alerting a called terminal in response to said call

establishment request, means for setting up, in response to said alerting, a two-way connection between a calling terminal and the called terminal, means for determining that a two-way voice call between the calling terminal and the called terminal is not allowed, means for receiving silent messages via the called terminal, and means for conveying information based on said silent messages to the calling terminal.

As will be discussed below, Cannell and Ahlberg fail to disclose or suggest the elements of any of the presently pending claims.

Cannell generally describes a method for a called phone to communicate with a calling party without answering a call request from the calling party. The called party and the calling party may, thus, transmit data responses to each other. If the calling party is not data-capable, the solution allows converting the data response into a voice message to the calling party (col. 1, lines 34-51 of Cannell)

At step 201 of FIG. 2 of Cannell, a call requested is transmitted from a calling phone to a called phone. At step 203, the called phone receives the call request. At step 205, it is determined if the called phone answers the call request. If the called phone does answer the call request, the call request is completed (206) and a call between the calling phone and the called phone is established. However, if the called phone does not answer the call request, the called phone determines (207) if the called phone wishes to send a data message to the calling phone. If not, the call request will not be completed and the process ends. If the called phone wishes to send a data message to the calling phone, the

system determines (209) if the calling phone is data capable. If so, the called phone sends (210) a data message to the phone and then the process ends.

The Office Action correctly recognized that Cannell clearly sets forth that a two-way communication is not set-up. Specifically, Cannel does not teach or suggest that in response to a detection of a call establishment request, “alerting the called terminal,” and “in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal,” as recited in independent claim 1. Cannell only detects that a call request is received. Instead of then setting up a two-way connection between the calling phone and the called phone, Cannell determines whether the called phone wishes to send a data message to the calling phone.

Thus, to resolve the deficiencies of Cannell, the Office Action relies on Ahlberg. Ahlberg describes that if a **user** of the cellular telephone **has actuated** the hold selection means, a communications link is established between the cellular telephone and the source telephone by an answering delay means, without opening the speaker 40 and the microphone 42 of the cellular telephone. Emphasis added. See FIG. 4, steps 88-90, and column 11, lines 45-57. In addition, according to Ahlberg, a predetermined message is preferably transmitted to the source telephone indicating that the telephone call has been **accepted** and that the user of the cellular telephone will be available momentarily. Emphasis added. Thus, the user can accept the telephone call without hindering their

current activities and can delay establishment of voice communications with the calling party until they have completed those activities. See column 3, lines 45-57.

Clearly, in view of the description provide in Ahlberg, a person of ordinary skill in the art would not be motivated to combine the descriptions of Cannell and Ahlberg. Ahlberg teaches away from determining that “a two-way voice call between the calling terminal and the called terminal is not allowed,” as recited in independent claim 1. For the system of Ahlberg to operate for its intended purpose, the telephone call, that is, the connection between the calling terminal and the called terminal must be accepted or allowed. Although Ahlberg describes a hold selection means by the user of the cellular telephone, for accepting the telephone call from the source telephone without establishing voice communications between the cellular telephone and the source telephone, Ahlberg does not teach or suggest that the voice communication between the cellular telephone and the source telephone is not allowed. The voice communication is in fact accepted or allowed by the system and method of Ahlberg. The voice communication is simply placed on hold until **the user** is ready to take the call. Although the system and method of Ahlberg has allowed the two-way call between the cellular telephone and the source telephone to be conducted, the user decides when to conduct the telephone call. Contrary to the contentions made in the Office Action, a person of ordinary skill in the art would not be motivated to combine the descriptions of Cannell and Ahlberg as both references achieve different results using incompatible embodiments.

In addition, independent claims 1, 11, 13, 20, 23, and 34 further recite that “in response to said determination,” the silent messages are received via the called terminal and/or the calling terminal. Furthermore, Cannell and Ahlberg do not teach or suggest, “in response to said determination, receiving silent messages via the called terminal and/or the calling terminal,” as recited in the independent claims. The Office Action’s contention that “it would therefore have been obvious to one of ordinary skill in the art to combine Ahlberg’s incoming call acceptance without voice communications feature with Cannell’s system in order to allow a called party to continue with an ongoing activity prior to establishing a desired voice communication with a calling party,” is merely a conclusive contention rather than motivation being found in Cannell and/or Ahlberg. Thus, the asserted combination of Cannell and Ahlberg would change the principle of operation of Cannell, or render Cannell inoperable for their intended purpose. See MPEP 2143.01. MPEP 2143.01 instructs that “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” However, such suggestion or motivation is not provided in either Cannell or Ahlberg.

Accordingly, Applicants respectfully assert that Cannell and Ahlberg, individually or combined, fail to teach or suggest all the recitations of independent claim 1. Because independent claims 11, 14, 20, 23, and 34 include similar claim features as those recited in independent claim 1, although of different scope, and because the Office Action refers

to similar portions of the cited references to reject independent claims 11, 14, 20, 23, and 34, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11, 14, 20, 23, and 34.

In view of the foregoing, it is respectfully requested that independent claims 1, 11, 14, 20, 23, and 34 and related dependent claims be allowed.

In the Office Action, at page 6, claims 17, 18, 31, and 32 were rejected under 35 U.S.C. § 103 as being unpatentable over Cannell and Ahlberg and further in view of U.S. Publication No. 2003/0097262 to Nelson ("Nelson"). Applicants respectfully traverse this rejection.

Dependent claims 17 and 18 depend from independent claim 14, and dependent claims 31 and 32 depend from independent claim 23. Because the combination of Cannell, Ahlberg, and Nelson must teach, individually or combined, all the recitations of the base claim and any intervening claims of dependent claims 17, 18, 31 and 32, the arguments presented above supporting the patentability of independent claims 14 and 23 over Cannell and Ahlberg are incorporated herein.

Nelson generally describes a handheld device including a receiver capable of receiving voice communications and a speaker for outputting voice communications as

audible speech to the user. The handheld device may include an input/output device for inputting text and/or commands and a text-to-speech processor that converts the input text to speech for transmission to another party. See Figs. 3-4, and paragraphs [0017] and [0023].

However, Nelson does not cure the deficiencies of Cannell and Ahlberg. Similarly to Cannell and Ahlberg, Nelson does not teach or suggest, in response to said detecting, alerting the called terminal, and in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal, as recited in independent claims 14 and 23. For similar reasons as previously set forth, because a combination of Cannell and Ahlberg would change the principle of operation of Cannell, or render Cannell inoperable for their intended purpose, a person of ordinary skill in the art would not be motivated to combine the descriptions of Cannell, Ahlberg, and Nelson.

In view of the foregoing, it is respectfully requested that claim dependent claims 17, 18, 31 and 32 be allowed.

At page 7 of the Office Action, claims 19 and 33 were rejected under 35 U.S.C. § 103 as being unpatentable over Cannell and Ahlberg and further in view of U. S. Patent No. 6,937,868 to Himmel et al. ("Himmel"). Applicants respectfully traverse this rejection.

Dependent claim 19 depends from independent claim 14, and dependent claim 33

depends from independent claim 23. Because the combination of Cannell, Ahlberg, and Himmel must teach, individually or combined, all the recitations of the base claim and any intervening claims of dependent claims 19 and 33, the arguments presented above supporting the patentability of independent claims 14 and 23 over Cannell and Ahlberg are incorporated herein.

Himmel generally describes an apparatus and method for managing a mobile phone answering mode and outgoing message **based on the location** of the mobile phone. Emphasis added. See column 1, lines 44-53. Himmel uses a location system to ascertain the current location of a mobile telephone being carried by a user. Based on the current location, Himmel determines whether various operations of the mobile telephone to receive and/or send calls should be inhibited.

However, similarly to Cannell and Ahlberg, Himmel does not teach or suggest, in response to said detecting, alerting the called terminal, and in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal, as recited in independent claims 14 and 23. Instead, in Himmel, the operations of the mobile telephone are dictated purely based on the location of the mobile telephone, now on whether a call establishment request is detected and, in response to said detecting, alerting the called terminal. Himmel does not cure the deficiencies of Cannell and Ahlberg. In addition, for similar reasons as previously set forth, because a combination of Cannell and Ahlberg would change the principle of operation of Cannell, or render

Cannell inoperable for their intended purpose, a person of ordinary skill in the art would not be motivated to combine the descriptions of Cannell, Ahlberg, and Himmel.

In view of the foregoing, it is respectfully requested that claims 19 and 33 be allowed.

At page 7, claims 3, 22, 24-27, 28, and 29 were rejected under 35 U.S.C. § 103 as being unpatentable over Cannell and Ahlberg and further in view of U. S. Patent No. 7,010,288 to Brown et al. ("Brown"). Applicants respectfully traverse this rejection.

Dependent claims 3, 24-26 depend from independent claim 1, dependent claims 22 and 29 depend from independent claim 20, dependent claim 27 depends from independent claim 11, and dependent claim 28 depends from independent claim 14. Because the combination of Cannell, Ahlberg, and Brown must teach, individually or combined, all the recitations of the base claim and any intervening claims of dependent claims 3, 22, 24-27, 28, and 29, the arguments presented above supporting the patentability of independent claims 1, 11, 14, and 20 over Cannell and Ahlberg are incorporated herein.

Brown generally describes a method for providing an automatic data response to a calling party when a called party is unable to participate in a voice call. (col. 2, lines 43-47; abstract). However, Brown does not cure the deficiencies of Cannell and Ahlberg. Similarly to Cannell, Brown does not teach or suggest, "in response to said detecting,

alerting the called terminal,” and “in response to said alerting, setting up a two-way connection between the calling terminal and the called terminal,” as recited in independent claim 1. For similar reasons as previously set forth, because a combination of Cannell and Ahlberg would change the principle of operation of Cannell, or render Cannell inoperable for their intended purpose, a person of ordinary skill in the art would not be motivated to combine the descriptions of Cannell, Ahlberg, and Brown.

In view of the foregoing, it is respectfully requested that claims 3, 22, 24-27, 28, and 29 and related dependent claims be allowed.

CONCLUSION:

In view of the above, Applicant respectfully submits that the claimed invention recites subject matter which is neither disclosed nor suggested in the cited prior art. Applicant further submits that the subject matter is more than sufficient to render the claimed invention unobvious to a person of skill in the art. Applicant therefore respectfully requests that each of claims 1-34 be found allowable and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the Applicant respectfully petitions for an appropriate extension of time.

Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Alicia Choi', is written over a horizontal line.

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Enclosures: Petition for Extension of Time
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